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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,616	01/14/2002	Michael H.J. Ohlmeyer	1073.035A	2697

23405 7590 07/17/2003

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/046,616

Applicant(s)

OHLMEYER ET AL.

Examiner

Venkataraman Balasubramanian

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-94 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

Claims 1-94 are pending.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 19-20, 24-26, 28, 48, 70 and 72-85 drawn to compound of formula I wherein X, Y and Z are nitrogens, namely triazine, composition and method of use, classified in class 544, subclasses 205, 206, 207, 208, 209, 213, 219, 220, class 514, subclass 241.
- II. Claims 1-18, 24-48, 70, and 72-85, drawn to compound of formula I wherein two of the X, Y and Z are nitrogens and the other CH, namely pyrimidine, composition and method of use, classified in class 544, subclasses 298, 309, 315, 319, 322, 323, 326, 327, class 514 subclasses 256, 269 and 275.
- III. Claims 1, 24-26, 28, 48, 70, and 72-85, drawn to wherein one of the X, Y and Z is a nitrogen and the other two CH, namely pyridine, composition and method of use, classified in class 546, subclasses 290, 296, 297, class 514, subclasses 345 and 349 other classes and subclasses depending upon the other heterocyclic rings.
- IV. Claims 1, 22-28, 48, 70, and 72-85 drawn to wherein all three of the X, Y and W are CH, namely benzene, composition and method of use, classified in class 564, subclass 306, class 568, subclasses 67, 584 and

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585, class 514, subclasses 647, 712, 717 etc. and other classes and subclasses depending upon the other heterocyclic rings.

- V. Claims 49-69, drawn to pharmaceutical composition with combination of active ingredients of compound of formula shown in claim 1 class 514, subclasses various depending upon the heterocyclic core selected from Group I-IV. If this invention is elected, applicants should elect a suitable X, Y and Z.
- VI. Claims 86-90, drawn to intermediate compound of formula shown on claim 86, class 544, subclass 310 class 514, subclass 274.
- VII. Claims 90-94, drawn to several benzofused compounds shown in these claims, class 546, subclasses 139, 205, class 549, subclass 398 class 558, subclass 411.

The inventions are distinct, each from the other because of the following reasons:

Invention I, II, III, IV, and VII are independent and distinct from each other because they are directed to structurally dissimilar compounds that lack common core such as triazine vs isomeric pyrimidine vs isomeric pyridine vs benzene core vs benzopyran vs tetrahydroquinoline vs tetrahydroisoquinoline. Consequently, the groups have different classifications and require separate prior art searches. They can be made and used independently. Art, which may render obvious or anticipate one of the groups would not necessarily do the same for the other group as evidenced by the references cited in the Information Disclosure Statement provided by the applicants. Each can support a patent, as the compounds of each group are capable of being utilized alone

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not in combination with other members listed in the Markush group. Placing all such compounds into the same claims is proper to scientific classification as they are separately classified and require separate searches.

Inventions II and VI are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as herbicides and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. See EP 0 096 657 cited in the Information Disclosure Statement. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions V and I-IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination i.e. the

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composition comprising compound of I-IV can be used either as pharmaceutical or as hair growth stimulant which does not require the combination of ingredients embraced in invention V and even if the compounds of I-IV were known in the prior art, the combination may be patentable. The subcombination has separate utility such as hair growth stimulant, hair loss retardant or therapeutic agent for treating diseases.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: triazine, pyrimidine, pyridine, aniline etc

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-94 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

In view of distinct nature of each of the inventions, the restriction is set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 5.30 PM.

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The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

*V. Balasubramanian*  
Venkataraman Balasubramanian

7/15/2003